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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,533	06/09/2000	EUGENIE CHARRIERE	004900-172	2035

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EXAMINER	
SERGENT, RABON A	
ART UNIT	**PAPER NUMBER**
1711	

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/485,533	CHARRIERE ET AL.	
	Examiner	Art Unit	
	Rabon Sergent	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *39-47,52-54,56-63 and 66-76* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *39-47,52-54,56-63 and 69-72* is/are allowed.

6)☒ Claim(s) *66-68 and 73-76* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Claims 66-68 and 73-76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to the biuret compound at the end of claim 66, despite applicants' response, it remains unclear how the biuret compound relates to the structure (VI). It remains unclear if the biuret contains the structure or if the structure is modified to yield the biuret.

Furthermore, the second structure of claim 66 has not been identified as Formula II. Applicants have failed to address this issue.

Lastly, the subject matter of independent claim 68 is indefinite, because formula X, formula VIII and formula XIII have not been identified.

2. Claims 66, 67, and 73-76 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Despite applicants' response, it is not clear that the specification provides support for the biuret compound of amended claim 66, and it is unclear what structure is possessed by the biuret. As aforementioned, it is unclear how the biuret compound relates to the structure (VI). It remains unclear if the biuret contains the structure or if the structure is modified to yield the biuret. Applicants' response that the biuretization of isocyanates is well-known in the art and the reference to Example 12 fails to adequately address the issue. The response does not clarify the structure of the biuret as it pertains to structure (VI), and the example is based upon a foreign reference that does not appear to be incorporated by reference.

Accordingly, the reference to the foreign document cannot provide support, within the meaning of the statute, with respect to the structure of the biuret.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 68 is rejected under 35 U.S.C. 102(e) as being anticipated by Lee et al. ('274).

Patentees disclose the use of uretidinedione containing polyisocyanate addition products as reactants for the production of coatings, adhesives, foams, and elastomers, wherein the addition products are reacted with polyols, such as polyacrylates and polyesters. See column 5, lines 53+ and column 9, lines 24+. Patentees further disclose that the addition products may be combined with additional polyisocyanate reactants such as isocyanurate containing polyisocyanates and biuret containing polyisocyanates. See column 4, line 42 and column 5, lines 31-35.

5. Since claim 68 does not require the presence of compounds corresponding to Formula (II) or Formula (III), the prior art rejection is deemed to be appropriate.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claim 68 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 44 and 45 of copending Application No. 10/682,412. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claim set is directed to blends comprising uretdiones and biurets. Furthermore, since the composition of the copending application is open to the inclusion of additional components and since the process of the copending application allows for mixtures of uretdiones, isocyanurates, and biurets, the position is taken that it would have been obvious to modify the aforementioned composition claims of the copending application to also contain isocyanurates.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Applicants' argument, with respect to the prior art rejection and the obviousness-type double patenting rejection, that claim 68 does not encompass mixtures of uretdiones and biurets is incorrect.

9. With respect to the claims, the language, "in the absence of a dimerization catalyst", "in the absence of dimerization catalyst", and "being free of dimerization catalysts", is considered to exclude all compounds that serve to catalyze the dimerization reaction of isocyanate groups.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
April 15, 2005

RABON SERGENT
PRIMARY EXAMINER